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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,103	01/17/2002	Takeshi Miyakawa	217829USOPCT	2093

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OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
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EXAMINER

NOLAN, SANDRA M

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action	Application No. 10/030,103	Applicant(s) MIYAKAWA ET AL.	
	Examiner Sandra M. Nolan	Art Unit 1772	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 26 July 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☒ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See the attachment.

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See the attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:


Claim(s) allowed: None.

Claim(s) objected to: None.

Claim(s) rejected: 2-12.

Claim(s) withdrawn from consideration: None.

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____


SANDRA M. NOLAN
PRIMARY EXAMINER

Attachment to Advisory Action

Claims

1. Claims 2-12 are pending.

Non-entry of Proposed Amendment

2. The proposed amendment to page 3 of the specification--i.e., the paragraph bridging pages 2 and 3 thereof--will not be entered because it contains new matter. There is no support in the original specification for the phrases "transparency tends to decrease" and "cloudiness tends to increase".

One basis for the proposed change is the same paragraph that applicants seek to change. Since the new language is not supported by the paragraph, that basis is not sufficient.

The other basis for the proposed change is the comparison of Example 3 with Comparative Example 3 in the table on page 4 of the specification. This basis is not sufficient because the data for of Example 3 with Comparative Example 3 is antithetic to that for the other two comparisons shown.

That is, comparing Examples 1 and 2 with their respective Comparative Examples, cloudiness percentages, which increase for the 3/Comp. 3 pair, decrease for the 1/Comp 1 and 2/Comp.2 pairs.

Accordingly, the proposed statement that "cloudiness tends to increase" is true for only one out of three cases shown and is not supported by the table.

It is noted that the proposed change to Comparative Example 2 in Table 1, if entered, would correct a typographical error but would create an inconsistency.

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Changing the PC resin percentage from "5" to -3-- would mandate changing the PET resin percentage from "95" to -97--.

Comment re: Kadova Citation

3. The form paragraph referring to Kadoya's having a U.S. filing date was included in the final action dated 10 May 2004 erroneously. As applicants noted on pages 5 and 6 of their 26 July 2004 response, that reference was inadvertent.

The examiner acknowledges applicants' desire to clarify the record and apologizes for any inconvenience caused by the mistake.

Response to Arguments

4. Applicant's arguments filed in the 2 July 2004 response have been fully considered but they are not persuasive.

The arguments presented on pages 6-9 of the 26 July 2004 response will be responded to in the order in which they were presented.

On page 6 of the response, applicants argue that the combination of Miyamoto and Kadoya is not proper because they are not analogous.

However, as the 13 August 2003 office action states, they both deal with packaging laminates.

In addition, Miyamoto deals with cover tapes that are sealed using heat, while Kodoya discusses packaging that is to be heated. See section 9 of the 13 August 2003 office action. Thus, both deal with packaging laminates that will be subjected to heat.

The propriety of the combination resides in the utility of the Miyamoto and Kadoya laminates as packaging materials, not in the type of goods they package.

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On pages 6-7 of their response, applicants argue that the combination of Kadoya with JP 05294376A (JP '376) is improper because they are not analogous.

However, as the 13 August 2003 office action states, they both deal with thermoplastic sheets having protective layers thereon.

Furthermore, the propriety of the combination resides in the utility of the Kadoya and JP'376 laminates as packaging materials, not in the type of goods they package.

Page 7, applicants argue that (1) the expanded polystyrene sheet of JP '376 would cause deterioration of the heat resistance and interfere with transparency in materials made using it and (2) JP'376's conductive coating is "inappropriate".

However, mere assertion, with nothing more, is not convincing. In the absence of convincing objective evidence to the contrary, the combination of Kadoya with JP '376 is deemed proper and the rejection is maintained.

On page 8, applicants assert that the combination of Kadoya with Kitaoka is improper because the references are nonanalogous. They then argue Kadoya lacks certain features and quote the examiner's motivation for the combination of Kadoya with Kitaoka.

However, the references both deal with packaging materials. Therefore, mere assertion that the combination is improper, with nothing more, is not convincing.

The absence of certain claimed features in the Kadoya disclosure does not render this 35 USC 103 rejection improper. It is not a 35 USC 102 rejection.

In addition, in the absence of convincing objective evidence, the features recited in applicants' claims 4 and 8 are deemed conventional.

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Lastly, the motivation provided for combining Kadoya with Kitaoka is proper because Kitaoka's antistatic layers would be expected to enhance the utility of packaging containing them for housing electronics. See pages 5 and 6 of the 13 August 2003 office action.

Conclusion

Any inquiry concerning this communication should be directed to Sandra M. Nolan, whose telephone number is 571/272-1495. She can normally be reached on Monday through Thursday, from 6:30 am to 4:00 pm, Eastern Time.

If attempts to reach the examiner are unsuccessful, her supervisor, Harold Pyon, can be reached at 571/272-1498.

The fax number for patent application documents is 703/872-9306.



S. M. Nolan
Primary Examiner
Technology Center 1700

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